

James M. McDonough et al.  
10/765,738  
Page 6

### REMARKS

In the Final Office Action mailed on May 16, 2006, the Examiner rejected claims 1, 2, 5-7, 10, 11, and 13-16 under 35 U.S.C. § 102(b) as being anticipated by Chase (U.S. Patent No. 3,414,268); rejected claim 8 under 35 U.S.C. § 103(a) as being unpatentable over Chase; rejected claim 12 under 35 U.S.C. § 103(a) as being unpatentable over Chase in view of Andrikian (U.S. Patent No. 5,383,668); rejected claims 17-19 under 35 U.S.C. § 103(a) as being unpatentable over Patterson (U.S. Patent No. 5,301,950); and indicated that claims 3 and 4 are allowable over the prior art (and apparently also claim 9, which was not cited as allowable but also not rejected).

Applicants have cancelled claim 13 and amended claims 14, 17, and 18. Therefore, claims 1-12 and 14-19 are currently pending.

The Examiner rejected claims 1, 2, 5-7, 10, 11, and 13-16 under 35 U.S.C. § 102(b) as being anticipated by Chase. The Examiner asserted that the portion marked "WEB" in the prior Amendment was indeed the web. Office Action at p. 3. The Examiner then stated:

The applicant asserts that the web does not extend between the leg members and is not independent of the shaft because the leg members extend radially from the cup. However, this is not persuasive as Figures 1 and 2 of Chase show the web member as extending between the leg members. Figure 2 is a cross section of Figure 1 between the leg members. Figure 2 clearly shows a member extending between and interconnecting the leg members.

Office Action at p. 3.

If the web member is as indicated in the Applicants' February 21, 2005 Amendment (to which the Examiner agreed) and as indicated on the drawing provided by the Examiner in the Final Office Action, then, as Applicants noted on page 8 of that Amendment, such an

James M. McDonough et al.  
10/765,738  
Page 7

interpretation leads to an inconsistent result if the reference is alleged to anticipate claim 1. That portion of the tee in Chase that the Examiner refers to as the web appears to contact and to be dependent on the shaft (15A). Thus, the reference cannot anticipate claim 1 as that claim requires that the web member be independent from the shaft. Applicants note that in the Examiner's response to Applicants' arguments in the Final Office Action the Examiner stated that "Figure 2 clearly shows a member extending between and interconnecting the leg members." The Examiner stopped there and did not discuss the limitation that the web member be independent of the shaft. And since the web is not independent, claim 1 is allowable.

The Examiner, on p. 3 of the Final Office Action, also rejected Applicants' argument that the legs are not connected to the shaft stating that since the legs are attached to the cup or bore 16 which is then attached to the shaft, the claim's limitations are met. Applicants merely argued this since, according to claim 1, the legs and the web cannot both be connected to the shaft and the Examiner appeared to be say that the web was attached to the shaft. If the Examiner interprets the reference such that the legs are attached to the shaft, then the web member in the golf tee in Chase must also be connected to the shaft (15A). Again, this precludes the Chase reference from anticipating the claim that requires that the web member be independent of the shaft. Thus, claim 1 is allowable over the references of record, as well as claims 2-12, which depend therefrom.

With respect to claim 14, Applicants have amended claim 14 to further differentiate the claimed invention from the device in Chase. Specifically, amended claim 14 requires,

James M. McDonough et al.  
10/765,738  
Page 8

inter alia, that the golf tee has an enlarged base having a flat bottom and that the shaft is substantially smaller in diameter than the enlarged base. The golf tee in Chase does not have a flat bottom or a shaft that is substantially smaller than the enlarged base, as is now required by amended claim 14. Thus, Chase does not disclose or suggest the invention claimed in amended claim 14. Claims 15 and 16, depending from allowable claim 14, are allowable for at least the same reasons.

The Examiner then rejected claim 12 under 35 U.S.C. § 103(a) as being unpatentable over Chase in view of Andrikian. As noted in the February 21, 2005 Amendment, claim 12 depends directly from claim 1, and is allowable for this reason alone. However, there are other reasons, which Applicants provided in that prior Amendment as well.

In the Final Office Action, the Examiner relied on the same bases for the rejections and then responded to the Applicants' arguments regarding claim 12. In particular, the Examiner stated that Applicants' arguments that the references teach away from one another are not persuasive because they are both directed to golf tees and nothing in Chase would preclude the modification as previously recited. The Examiner also indicated that Applicants' assertion that Examiner does not provide any reasoning as to why the references could not be combined is not well taken because the Examiner clearly stated "that it would have been obvious to one of ordinary skill in the art to form the tee of Chase with an enlarged base in order to allow the tee to be used in the driving range environment." Office Action at p. 5.

James M. McDonough et al.  
10/765,738  
Page 9

However, the standard for the propriety of combining references is not whether the disclosures "would preclude the modification as recited." Rather, the Examiner must provide factual bases for the motivation of the combination, and a mere assertion that one of ordinary skill in the art would do so was counseled against by the Federal Circuit as being clearly improper for failing to provide factual basis for the motivation. See, e.g., In re Lee, 277 F.3d 1338, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002) ("Thus when they rely on what they assert to be general knowledge to negate patentability, that knowledge must be articulated and placed on the record. The failure to do so is not consistent with either effective administrative procedure or effective judicial review. The board cannot rely on conclusory statements when dealing with particular combinations of prior art and specific claims, but must set forth the rationale on which it relies."). In fact, the reasoning given in the present application is eerily similar to that which was rejected in In re Lee.

Furthermore, Applicants assert that the Examiner is using impermissible hindsight and has taken what has been taught by the invention and stated that it would be obvious to combine the two references without any factual basis. See, e.g., W.L. Gore v. Garlock, Inc., 721 F.2d 1540, 1553, 220 U.S.P.Q. (BNA) 303, 312-13 (Fed. Cir. 1983) (cautioning against the "insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher."). The statement by the Examiner that nothing in the disclosures "would preclude this modification" clearly indicates that hindsight was used.

To the extent that the Examiner is relying on his own personal knowledge of what one of ordinary skill in the art would use as to the reasons to combine these references,

James M. McDonough et al.  
10/765,738  
Page 10

Applicants request that the Examiner provide those facts in an appropriate affidavit. 37  
C.F.R. §1.104(d)(2).

Lastly, contrary to the Examiner's assertions, Applicants provided reasons that one of ordinary skill in the art would not have combined the references. Applicants asserted that since the tee in Chase was clearly for use in the ground with the pointed end and if the tee were to be used on a flat surface, the tee would be used without the pointed shaft and only with the top portion (without a shaft). Since the reference provides a solution for a flat surface, one of ordinary skill in the art would not go looking for an alternative to the pointed tip.

The Examiner then rejected claims 17-19 under 35 U.S.C. § 103(a) as being unpatentable over Patterson. In the present Office Action, the Examiner cited to a definition from a dictionary concerning "leg." Office Action at p. 5. However, Applicants believe that such a citation from a dictionary is misplaced. The place to start with the definition of any claim terms, to the extent any definitions are needed, is the intrinsic sources – namely the patent documents themselves. The need for such extrinsic sources should be limited to those instances when needed to understand the underlying technology and when construing claims, so long as the definition does not contradict the definition found in or ascertained by the reading the patent documents. See Vitronics Corp. v. Conceptronic, Inc., 90 F.3d 1576, 1584 n.6 (Fed. Cir. 1996). Applicants do not believe now or in the last Amendment that the definition of leg was an issue. As noted in the last Amendment, Applicants only took issue with the reference numeral cited by the Examiner as an edge and not as a leg.

James M. McDonough et al.  
10/765,738  
Page 11

Applicants have, in this Amendment, amended claim 17 to require that web member is independent from the shaft and that the golf ball rests only on the three legs. In the Office Action, the Examiner has indicated that the resilient strip 32 of Chase [sic; Patterson] is a web member because it functions as the web member of the present invention. Given that interpretation and agreeing that Patterson discloses that the tee therein may have a "number of resilient strips," the reference still fails to disclose or suggest the claimed invention.<sup>1</sup> Amended claim 17 requires that the web member extending between the at least three legs is independent of the shaft and the web portion 32 of Patterson is not independent of the shaft 24. In fact, the web portion 32 of Patterson (as defined by the Examiner) is a contiguous part of the shaft 24. Furthermore, amended claim 17 also requires that the ball rest only on the legs. However, Patterson makes it clear that resilient strip 32 functions as a leg and provides support to the golf ball. See col. 5, lines 19-31. Thus, Patterson does not disclose or suggest the claimed invention.

Applicants have also amended claim 18 to require that the top portion of the golf tee extends at least partially outward in a radial direction from the shaft and the golf ball rests only on the three legs. As noted above, the golf ball in Patterson rests on the leg and the web member (as interpreted by the Examiner). Additionally, the golf tee in Patterson does not have a top portion that extends at least partially outward in a radial direction from the shaft. Thus, amended claim 18 is also allowable.


---

<sup>1</sup> Applicants still dispute that Patterson discloses three legs. Patterson discloses modified seat portions in Figs. 2, 3, 5, and 6, but all have only one contiguous seat portion and one web.

James M. McDonough et al.  
10/765,738  
Page 12

In light of the foregoing remarks, this application is now in condition for allowance and early passage of this case to issue is respectfully requested. No other fees are believed to be due with this submission. The Patent Examiner is welcomed to telephone the undersigned to discuss the merits of this patent application.

Respectfully submitted,

  
Michael L. Leetzow  
Registration No. 35,932  
Michael L. Leetzow, P.A.  
5213 Shoreline Circle  
Sanford, FL 32771  
Telephone: 407/302-9970

Date: 8/16/05